

REMARKS

Claims 1-15, 17-22 and 24-30 are currently pending in the subject application and are presently under consideration. Claims 1, 19 and 28 have been amended as shown at pages 2-9 of the Reply. In addition, a declaration in support of the argument under 103(c) below is being filed along with this Reply.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-15, 17-22, 24-26 and 28-30 Under 35 U.S.C. §102(b)

Claims 1-15, 17-22, 24-26 and 28-30 stand rejected under 35 U.S.C. §102(b) as being anticipated by Pepe *et al.* (US 5,742,905). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. The cited reference does not teach or suggest each and every limitation set forth in the subject claims.

“A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987) Emphasis added. “The identical invention must be shown in as complete detail as is contained in the...claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1 recites in part ... a mechanism designed to access and store information regarding context information and notification parameters, ***the notification parameters including at least one of a relevance parameter that indicates whether information given context thereof is relevant to a user's context, a novelty parameter that indicates whether information is new to the user, and a fidelity parameter that indicates loss of value of information due to truncation and/or summarization of the information.*** Such claimed features of applicants' invention provides for a highly automated and accurate notification system that dynamically considers context of information desired to be conveyed to a user in connection with relevance thereof to context of the user, newness of the information to the user and loss of value of the information due to conveying a sparse representation of the information ... so as to optimize conveyance of notifications. Pepe *et al.* neither teaches nor suggests (let

alone contemplates the significance) of the aforementioned aspects of the subject claims. The cited reference teaches a user profile based notification system that focuses on preferences specified by the user to direct messages. Specifically, the section of the Pepe *et al.* cited in the Office Action, column 23, lines 50-62, does not disclose context of information or context of the user, let alone employing both contexts in determining relevance parameter. This section merely indicates that *a user may select* a particular device to be employed based upon their current location. This is a user specified device choice, not context information. Furthermore, Pepe *et al.* is silent regarding a novelty parameter that indicates whether information is new to the user, and a fidelity parameter that indicates loss of value of information due to truncation and/or summarization of the information. Moreover, independent claims 1 (and similarly independent claims 19, 28 and 30) recite at least one notification sink, each sink designed to receive the notifications and having parameters associated with it representing at least one of: ***a transmission reliability of the notification sink indicating a likelihood that the user will receive information contained within a notification conveyed to the notification sink, a cost of communication of the notification sink indicating a communication cost incurred by the user when receiving information contained within a notification conveyed to the notification sink, and a cost of disruption of the notification sink indicating a disruption cost incurred by the user when receiving information contained within a notification conveyed to the notification sink.*** Pepe *et al.* is silent regarding these novel parameters of the notification sink.

In addition, independent claim 24 recites at least one notification source, each source designed to generate notifications intended for the user, and having parameters associated with it representing ***at least three of***: a) an importance of a current notification generated by the notification source indicating value of information contained in the current notification to the user; b) a time criticality of the current notification generated by the notification source indicating time-dependent decay of the value of the information contained in the current notification to the user; c) a relevance of the current notification indicating a likelihood of the relevance of information contained in the current notification to the user; d) a novelty of the current notification indicating a likelihood of whether the user already knows the information; and e) a fidelity of the current notification indicating a loss of value to the user of the information upon truncation of the information. The Office Action indicates that claims 24-27 are allowed and also indicates a rejection of these claims without providing any supporting reasoning or

specific citation from the prior art. In response to the rejection of claim 24, Pepe *et al.* fails to disclose a notification source having three of the parameters disclosed in the subject claim and specifically, is silent regarding a time criticality of the current notification generated by the notification source indicating time-dependent decay of the value of the information contained in the current notification to the user; a relevance of the current notification indicating a likelihood of the relevance of information contained in the current notification to the user; a novelty of the current notification indicating a likelihood of whether the user already knows the information; and a fidelity of the current notification indicating a loss of value to the user of the information upon truncation of the information.

In view of at least the foregoing discussion, applicants' representative respectfully submits that Pepe *et al.* fails to teach or suggest all limitations of applicants' invention as recited in independent claims 1, 19, 24 and 30 (and all claims that respectfully depend there from), and thus fails to anticipate the subject claimed invention. Accordingly, this rejection should be withdrawn.

II. Rejection of Claims 19-23 Under 35 U.S.C. §103(a)

Claims 19-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Pepe *et al.* (US 5,742,905) as applied to claims 1, 6, 12, 14 and 13 above, and further in view of Macskassy *et al.* (EmailValet: Learning Email Preferences for Wireless Platforms). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Pepe *et al.* and Macskassy *et al.*, alone or in combination, do not teach each and every element of applicants' invention as recited in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of

success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Independent claim 19 recites *a transmission reliability of the notification sink indicating a likelihood that the user will receive information contained within a notification conveyed to the notification sink, a cost of communication of the notification sink indicating a communication cost incurred by the user when receiving information contained within a notification conveyed to the notification sink, and a cost of disruption of the notification sink indicating a disruption cost incurred by the user when receiving information contained within a notification conveyed to the notification sink*. As discussed above Pepe *et al.* fails to teach or suggest these novel features of the subject claim and Macskassy *et al.* fails to make up for the aforementioned deficiencies of Pepe *et al.* Macskassy *et al.* discloses an e-mail forwarding system that learns user preferences for downloading e-mail to their portable device. However, the cited art is silent regarding the novel parameters recited in the subject claim. Accordingly, this rejection should be withdrawn.

III. Rejection of Claims 1-15, 17-22 and 28-30 Under 35 U.S.C. §103(a)

Claims 1-15, 17-22 and 28-30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Pepe *et al.* (US 5,742,905) in view of Horvitz *et al.* "Attention Sensitive Alerting in Computing Systems". It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. As discussed above with respect to independent claims 1, 19, 28 and 30, Pepe *et al.* and do not teach each and every element of applicants' invention as recited in the subject claims and Horvitz *et al.* is not citable art with respect to the present patent application. The following is a quotation of 35 U.S.C. §103(c) which forms at least one basis for withdrawal of all rejections in this Office action:

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (e), (f), and or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The subject matter of Horvitz *et al.* and the claimed invention were, at the time the invention was made, subject to an obligation of assignment to Microsoft Corporation. Furthermore, as declared by the inventors in the submitted affidavit pursuant to 37 C.F.R. §1.132, the cited document “Attention Sensitive Alerting in Computing Systems” was published within one year before the filing date of the subject application and the cited document was derived from the work of the inventors identified in the subject application. Therefore, the cited document is not citable art with respect to the subject claims. Accordingly, withdrawal of this rejection is respectfully requested.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP228US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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